THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG RITTER

Appeal No. 96-2432
Application No. 08/066,087[1]

ON BRIEF

Before KIMLIN, JOHN D. SMITH and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21-26 and 28-45. Claims 46-78, the other claims remaining in the

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[1] Application for patent filed May 26, 1993. According to appellant, this application is a National stage application under 35 U.S.C. § 371 of PCT/EP91/02169, filed November 18, 1991.

present application, stand withdrawn from consideration.

Claim 21 is illustrative:

21. A composition of matter useful as a high-strength material which is degradable and resorbable in the human and animal organisms comprising cured (meth)acrylic acid esters of polyfunctionally hydroxyl-terminated oligomers of lower hydroxycarboxylic acids, wherein said (meth)acrylic acid esters of polyfunctionally hydroxyl-terminated oligomers of lower hydroxycarboxylic acids have been prepared under solvent-free conditions in the steps of the production of the oligomer(s), the conversion thereof to the poly-functional (meth)acrylic acid esters and the curing-shaping thereof, and three-dimensionally cross-linked by boron-free, free radical-initiated polymerization and exhibit a tensile strength of at least $10N/mm^2$.

In the rejection of the appealed claims, the examiner relies upon the following reference:

Ritter	4,731,425	Mar. 15, 1988

Appellant's claimed invention is directed to cured (meth)acrylic acid esters of polyfunctionally hydroxyl-terminated oligomers of lower hydroxycarboxylic acids that have been prepared under solvent-free conditions. The cured esters exhibit a tensile strength of at least $10N/mm^2$. The cured esters of the present invention find utility as high-strength materials that are degradable and resorbable in human and animal organisms such that they can be used as pins for the fixation of bone fragments.

Appealed claims 21-26 and 28-45 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Ritter.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

Ritter discloses the preparation of cured (meth)acrylic acid esters of polyfunctionally hydroxyl-terminated oligomers of lower hydroxycarboxylic acids. However, Ritter does not teach that the esters are prepared under solvent-free conditions, as required by the appealed claims, and the reference is silent with respect to the tensile strength of the cured esters. According to the examiner, since Ritter discloses the preparation of esters by reacting the same components recited in the appealed claims, "the burden shifts to appellant to show that the claimed product is novel and unobvious" (page 4 of Answer).

It is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the product of the prior art does not necessarily or

inherently possess characteristics attributed to the claimed product. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In such situations it is the examiner's initial burden to demonstrate such a close correspondence between the products of the applicant and the prior art that it can be reasonably concluded that both products are essentially the same in properties. As an example, the examiner may demonstrate that both the claimed and prior art products are produced by essentially the same process.

In the present case, we find that the examiner has failed to make the case that the cured coatings of Ritter's EXAMPLE 21 inherently exhibit the claimed tensile strength. As appreciated by the examiner, although the ester of EXAMPLE 21 is "in pure form," the ester was not prepared under solvent-free conditions, as required by the appealed claims. Since appellant's esters and Ritter's esters are prepared under different conditions, it is incumbent upon the examiner to establish that one of ordinary skill in the art would reasonably expect the different reaction conditions to, nevertheless, produce essentially the same product. Since the

examiner has failed to do so on this record, we find that the examiner's position is lacking the requisite factual support to shift to appellant the burden of proving that the reference cured esters do not have the claimed tensile strength.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
JOHN D. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

clm

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